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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,696	08/09/2001	Ing Vojtech Benetka	PH44	4284

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EXAMINER

GRUNBERG, ANNE MARIE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 10/15/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/925,696

Applicant(s)
Ing Vojtech Benetka

Examiner
Anne Marie Grunberg

Art Unit
1661



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 9, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Aug 9, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☒ Other: Requirement for Information 105

DETAILED ACTION

Drawings

The drawings have been accepted by an official draftsman.

Arrangement of the Specification

1. With the passage of the American Inventors' Protection Act, Applicants' attention is drawn to 37 CFR 1.163(c)-(d) which is reproduced below:

37 CFR 1.163. Specification and arrangement of application elements in a plant application.

(c) The specification should include the following sections in order:

- (1) Title of the invention, which may include an introductory portion stating the name, citizenship, and residence of the applicant.
- (2) Cross-reference to related applications (unless included in the application data sheet).
- (3) Statement regarding federally sponsored research or development.
- (4) Latin name of the genus and species of the plant claimed.
- (5) Variety denomination.
- (6) Background of the invention.

- (7) Brief summary of the invention.
- (8) Brief description of the drawing.
- (9) Detailed botanical description.
- (10) A single claim.
- (11) Abstract of the disclosure.

(d) The text of the specification or sections defined in paragraph (c) of this section, if applicable, should be preceded by a section heading in upper case, without underlining or bold type.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the instant plant has not been set forth in the disclosure. 37 CFR 1.163(c)(4). Applicant needs to clarify the genus and species of 'Pink Poppet' using the appropriate Latin binomial. Additionally, it appears that the Latin binomial cited for 'Eva Rathke' is incorrect. According to the RHS Dictionary, there is no such genus and species as *Weigela hybrida* and 'Eva Rathke' is listed as a *Weigela florida* (see page 704, column 1). The enclosed web site also lists 'Eva Rathke' as a *Weigela florida*. If the genus and species of the instant plant or its parents differ from what is recited in the RHS Dictionary, documentation supporting the validity of the assertions should be set forth in the response to this office action.

B. At page 1, starting at line 17, it states that "The F₂ generation was cultivated for seven years." This implies that the F₂ generation was seven years old. However, the specification then continues with "The seven generations of vegetative propagation..." This is confusing because of the recitation of "the" propagations that have not been previously explained. This also implies that the F₂ generation was asexually reproduced seven times. The terms "cultivated" and "propagation" have different definitions making the intended meaning unclear. As a result, this section of the specification should be rewritten for purposes of clarity.

C. The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents. Although the specification states that the closest comparison plants are its parents and that the instant plant is distinguished from its parents by leaf size, shorter internodes, smaller stems, and flower color, the characteristics described have not distinguished the plant from its parents since there is no specific comparison made to the parents. As a result, the distinguishing characteristics should be quantified. Applicant should set forth the size, leaf size, internode length, stem size, and flower color of each of its parents.

D. In order to provide as complete a botanical description as is reasonably possible, Applicant should set forth the sizes of the reproductive organs, duration of bloom, whether the flowers are self-cleaning, and a characterization of the scent. Additionally, information should be set forth as to whether the plant is evergreen or deciduous.

E. Where color is a distinctive feature of the plant, the color should be positively identified in the specification by reference to a designated color as given by a recognized color dictionary or color chart. As a result, stem, branch, leaf midrib and

venation, petiole, sepal, style, stigma, pollen, anther, and filament color designations, should be set forth in the specification.

F. Applicant makes references to multiple color designations wherein the color designations are separated by a “,”, such as for example, “RHS 70B,C”. It is unclear if Applicant is specifying that the color designations reflect a range in color, or if the colors appear at different geographical locations on the organ, or if some individual organs have one color whereas other organs of the same type, on the same plant, have different colors. Applicant should clarify each occurrence of “,”, such as in regard to outside flower petal and bud color, for example.

G. A “hit” on the UPOV-rom was found for a weigela variety ‘Piccolo’ with an application filing number 679 and has the Czech identifier PBR 0WEI06556, filing date 11/02/1995. It appears that ‘Piccolo’ is the same variety as ‘Pink Poppet’, based on information supplied in the declaration of the instant US application for plant patent. Ordinarily, the denomination proposed for registration in the United States must be the same as the denomination registered in another member state of UPOV. As a result, Applicant should specify whether ‘Pink Poppet’ is the same as ‘Piccolo’, and if the same, the name ‘Pink Poppet’ is objected to.

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejections

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Information Assessment

1. The claimed Weigela plant is described in the following Plant Breeder's Right number: Czech Rep. 679 as specified in the declaration. The Czech PBR has a published application filing date of 02 November 1995. This date is more than one year prior to the filing date of the instant application. The published grant, application and published proposed denomination are each "printed publications" under 35 U.S.C. 102 because they are accessible to persons concerned with the art to

which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. For example, UPOV publishes the application number and grant number, date of publication, species of plant and variety denomination for PBR certificates, and copies of the grant are obtainable through the Board of Plant Breeders' Rights of the countries in question and is public information. Thus information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art. Additionally, it appears that the variety 'Piccolo' may be the same variety as 'Pink Poppet'.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992)(“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”).

While the publications cited above disclose the claimed plant variety, a question remains as to whether the references are enabling. If the plant was publicly available, then the application, proposed denomination or granted PBR certificate, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of electronic databases, the Internet and the Office's collection of retail catalogs has not revealed information pertaining to the instant plant. However, the Office's collection of retail catalogs is not comprehensive. Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties free of charge. Since the inventor and assignee of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information in the attached Requirement for Information Under 37 CFR 1.105.

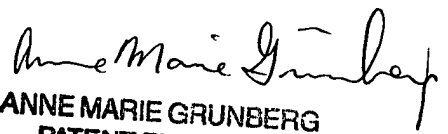
This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

Future Correspondence

Any inquiry concerning this communication from the Examiner should be directed to Anne Marie Grünberg whose telephone number is (703) 305-0805. The Examiner can normally be reached Monday through Thursday from 6:00 am to 3:30 pm and alternate Fridays from 7:00 am to 3:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205. The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.


ANNE MARIE GRUNBERG
PATENT EXAMINER

ATTACHMENT

REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to determine when, the claimed plant variety, 'Pink Poppet', was publicly available prior to the filing date of the instant application, including any release of the variety under any other name.

In response to this requirement please provide any information available regarding the sale or other public distribution of the claimed plant variety **anywhere in the world**, including the date(s) of any sale or other public distribution prior to the application for U.S. patent. Also, please provide copies of the application, published proposed denomination and published Breeder's Right grant. The Office does not maintain a collection of Breeders' Rights documents and they are not readily obtainable electronically.

As discussed in the office action, it appears that "Pink Poppet" is the same plant as 'Piccolo'. Applicant is required to verify whether "Pink Poppet" is the same as

'Piccolo' as well as to provide any information available regarding the sale or other public distribution of 'Piccolo', if indeed they are the same invention, **anywhere in the world**, including the date(s) of any sale or other public distribution prior to the application for U.S. patent. Also, please provide copies of the application, published proposed denomination and published Breeder's Right grant.

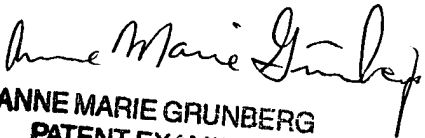
The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

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This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.


ANNE MARIE GRUNBERG
PATENT EXAMINER